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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,563	08/02/2000	Keiichi Nakajima	PM 271791 NI-0006PCTUS	9970
909	7590	09/12/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,563

Applicant(s)

NAKAJIMA, KEIICHI

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 20 June 2005 has been entered.

Response to Amendment

All pending claims (1-35) were examined in this non-final office action.

Response to Arguments

Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection. Mobile Commerce teaches industry movement to telephony-based Internet commerce in order to capture a growing based of mobile phone users and investigating payment systems. Payne teaches a payment system, billing and settlement.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 1. Claims 28-30, 32, 34, and 35 are rejected under 35 USC 102(b) as being anticipated by Payne et al. (US 5,715,314, hereinafter referred to as “Payne” which incorporates in its entirety “Digital Active Advertising” serial no. 08/168,519, now abandoned, thereby incorporating in its entirety US 5,724,424 “Digital Active Advertising” a continuation of serial no. 08/168,519).**

Payne teaches all the limitations of claims 28-35. For example, Payne discloses an electronic commerce system used to purchase electronic content and/or hard goods comprising a buyer computer, a merchant computer, and a payment computer with access to a settlement database and a shopping cart database (see at least Fig. 1). Payne further discloses:

- *Establishing communication to a billing terminal (e.g. cashier server) based on information identifying the billing terminal:* user terminal is in communication with payment computer (comprising a settlement database) that communicates with a real-time financial authorization network (see at least Fig. 13 (300); col. 7, line 65 through col. 8, line 7).

- Setting a transaction identifying number to identify an order transaction of an item; user ID: buyer computer sends payment computer payment URL A which comprises a product identifier, domain identifier that represents a domain of products to which the desired product belongs (please note examiner's interpretation: a catalog number, an advertising promotion number, etc), a merchant computer identifier, merchant account identifier, payment amount (see at least Fig. 2A (34); col. 5, lines 26-47);
- Paying terminal transmits the information identifying the billing terminal to the settlement apparatus: Inherent in Payne are the structures necessary to permit the paying terminal to identify the billing terminal to the settlement apparatus. For example, the user supplies credit card account information that identifies the credit card company used to check credit status (see at least Fig. 2G (76); Fig. 7; col. 7, lines 14-17).
- Transmitting information about the billing terminal with the transaction identifying number to the paying terminal: (see at least Fig. 2C (44); Fig. 6; col. 6, lines 9-14).
- Synchronizing a communication to the billing terminal with a communication to the paying terminal when the paying terminal confirms the information about the billing terminal and transmits the transaction

identifying number as a user input information to the settlement apparatus:

(see at least Fig. 2C (62); col. 6, lines 30-59).

- Transmitting a synchronization confirmation signal which indicates that the synchronization is established with the billing terminal: Inherent in Payne are the structures necessary to permit synchronization between paying terminal (user terminal) processes, billing processes, and settlement processes.
- Receiving the order of the item from the paying terminal: payment computer receives order by buyer (see at least Fig. 2A (32, 34); col. 5, lines 26-30).
- Transmitting the order of the item received from the paying terminal to the billing terminal:
- Receiving a purchase amount based on the order of the item from the billing terminal: payment URL from buyer indicates payment amount that include price of product; actual amount (see at least col. 5, lines 30-35; col. 7, lines 5-30).
- Performing a process of settlement of the transaction between the billing terminal and the paying terminal, both of which are synchronized with each other by the transaction identifying number based on the purchase amount: performs settlement using a transaction detail URL that includes a transaction identifier, a buyer network address, and a transaction detail URL authenticator (see at least col. 9, lines 3-18).

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- System: computers providing a) user interface and communications over the Internet, b) billing, credit checking, account management, and settlement processing; merchant product information (see at least Fig. 1).
- Computer readable medium: Inherent in Payne are the structures necessary to permit the embodiment of computer instruction code into computer readable medium executable by computers that comprise the network sales system.
- Communication units: Inherent in Payne are the structures necessary to permit communication between computers connected to the network.
- Paying terminal: buyer computer (see Fig. 1 (12, 14)).
- Billing terminal: payment computer performs billing functions (see Fig. 1 (16, 22)).
- Settlement apparatus: computer structures necessary to manage settlement database (see Fig. 1 (22)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-11, 15, 17, 18, 20-27, 31, and 33 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (Paper #7, PTO-892, Items: U and V), in view of Payne (US 5,715,314, which incorporates in its entirety "Digital Active Advertising" serial no. 08/168,519, now abandoned, thereby incorporating in its entirety US 5,724,424 "Digital Active Advertising" a continuation of serial no. 08/168,519).**

Mobile Commerce teaches turning the cellular phone into an electronic purse handling case, loyalty points, tickets, and identification (please note: cellular phone connects to commerce system using RF communications network). Mobile Commerce teaches mobile commerce attracting 5 million consumers desiring to use mobile commerce. Mobile Commerce teaches users using access codes, authorizing secure payments or transfers to other accounts, paying bill or checking account balances, and using smart cards to securely access banking services (Paper #7, PTO-892, Item: U, see pages 1 and 2).

Mobile Commerce teaches all the above as noted under the 103(a) rejection and further teaches the Mobile Commerce forum investigating integrating payment systems with mobile telecommunications (Paper #7, PTO-892, Item: V, see at least page 2), but does not disclose any details on what types of payment systems are being investigated. Payne teaches a payment system to support electronic commerce. Payne teaches consumers (buyers) purchasing electronic content and/or hard goods over a payment system comprising buyer computers, a merchant computers, and a payment computer with access to a settlement

database and a shopping cart database (see at least Fig. 1). Payne further teaches:

- Establishing communication to a billing terminal (e.g. cashier server) based on information identifying the billing terminal: user terminal is in communication with payment computer (comprising a settlement database) that communicates with a real-time financial authorization network (see at least Fig. 13 (300); col. 7, line 65 through col. 8, line 7).
- Setting a transaction identifying number to identify an order transaction of an item; user ID: buyer computer sends payment computer payment URL A which comprises a product identifier, domain identifier that represents a domain of products to which the desired product belongs (please note examiner's interpretation: a catalog number, an advertising promotion number, etc), a merchant computer identifier, merchant account identifier, payment amount (see at least Fig. 2A (34); col. 5, lines 26-47);
- Paying terminal transmits the information identifying the billing terminal to the settlement apparatus: Inherent in Payne are the structures necessary to permit the paying terminal to identify the billing terminal to the settlement apparatus. For example, the user supplies credit card account information that identifies the credit card company used to check credit status (see at least Fig. 2G (76); Fig. 7; col. 7, lines 14-17).

- Transmitting information about the billing terminal with the transaction identifying number to the paying terminal: (see at least Fig. 2C (44); Fig. 6; col. 6, lines 9-14).
- Synchronizing a communication to the billing terminal with a communication to the paying terminal when the paying terminal confirms the information about the billing terminal and transmits the transaction identifying number as a user input information to the settlement apparatus: (see at least Fig. 2C (62); col. 6, lines 30-59).
- Transmitting a synchronization confirmation signal which indicates that the synchronization is established with the billing terminal: Inherent in Payne are the structures necessary to permit synchronization between paying terminal (user terminal) processes, billing processes, and settlement processes.
- Receiving the order of the item from the paying terminal: payment computer receives order by buyer (see at least Fig. 2A (32, 34); col. 5, lines 26-30).
- Transmitting the order of the item received from the paying terminal to the billing terminal:
- Receiving a purchase amount based on the order of the item from the billing terminal: payment URL from buyer indicates payment amount that include price of product; actual amount (see at least col. 5, lines 30-35; col. 7, lines 5-30).

- Performing a process of settlement of the transaction between the billing terminal and the paying terminal, both of which are synchronized with each other by the transaction identifying number based on the purchase amount: performs settlement using a transaction detail URL that includes a transaction identifier, a buyer network address, and a transaction detail URL authenticator (see at least col. 9, lines 3-18).
- System: computers providing a) user interface and communications over the Internet, b) billing, credit checking, account management, and settlement processing; merchant product information (see at least Fig. 1).
- Computer readable medium: Inherent in Payne are the structures necessary to permit the embodiment of computer instruction code into computer readable medium executable by computers that comprise the network sales system.
- Communication units: Inherent in Payne are the structures necessary to permit communication between computers connected to the network.
- Paying terminal: buyer computer (see Fig. 1 (12, 14)).
- Billing terminal: payment computer performs billing functions (see Fig. 1 (16, 22)).
- Settlement apparatus: computer structures necessary to manage settlement database (see Fig. 1 (22)).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Mobile Commerce to integrate a

payment system that integrates billing and settlement as taught by Payne, in order to provide mobile commerce users with same or similar billing and settlement processing as provided for buyer computers directly connected to the Internet, and thereby increase sales for merchants by capturing approximately 5 million mobile telephone users.

- 3. Claims 12-14 is rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (Paper #7, PTO-892, Items: U and V) and Payne (US 5,715,314, which incorporates in its entirety "Digital Active Advertising" serial no. 08/168,519, now abandoned, thereby incorporating in its entirety US 5,724,424 "Digital Active Advertising" a continuation of serial no. 08/168,519 hereinafter referred to as "Gifford"), as applied to claim 7, further in view of Beck et al. (US 6,332,154 hereinafter referred to as "Beck").**

Mobile Commerce and Payne teach all the above as noted under the 103(a) rejection and teach integrating telephony systems with Internet commerce, but do not disclose detecting a telephone number and retrieving user status. Beck teaches a telephony system, Automatic Number Identification (ANI), providing customer convenience via self-service commerce, and further teaches retrieving caller information (e.g. purchase history, payment history) (see at least abstract; col. 9, line 6-17, col. 36, lines 20-29). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and

method of Mobile Commerce and Payne to implement call detection and record retrieval as taught by Beck, in order to provide a customer convenience, and thereby attract customers to the service.

- 4. Claims 16 and 19 are rejected under 35 USC 103(a) as being unpatentable over Mobile Commerce (Paper #7, PTO-892, Items: U and V) and Payne (US 5,715,314, which incorporates in its entirety "Digital Active Advertising" serial no. 08/168,519, now abandoned, thereby incorporating in its entirety US 5,724,424 "Digital Active Advertising" a continuation of serial no. 08/168,519 hereinafter referred to as "Gifford"), as applied to claim 5, further in view of Meyers (Paper #7, PTO-892, Item: WW).**

Mobile Commerce and Payne teach all the above as noted under the 103(a) rejection and teach a) wireless applications as merging Internet content and advanced telephony services, b) using smart cards to prevent fraud, and c) authentication methods to identify the customer, but do not disclose voice prints for identification. Meyers teaches GTE Telecommunication Services introducing speaker identification technology available to wireless carriers that identifies callers by using a voice print rather than a numeric code. Meyers further teaches the system being well-suited for wireless applications for evaluating the authority of users based on a pre-recorded password, voice print, and other biometric characteristics (Paper #7, PTO-892, Item: WW, see pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention

to modify the system and method of Mobile Commerce and Payne to include voice prints as another way to authenticate a user as taught by Meyers, in order to enhance security and to provide a customer convenience, and thereby attract customers to the service.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,890,137 (Koreeda) 30 March 1999; teaches electronic commerce, settlement using service center and approval center.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', with a stylized, cursive script.

Robert M. Pond
Primary Examiner
August 31, 2005